

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

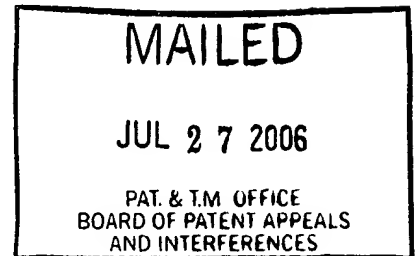
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADAMASA KITSUKAWA, TSUTOMU AKIYAMA, FREDERICK J.
ZUSTAK, HANS MAHR and ADITYA KRISHNAN

Appeal No. 2006-1895
Application No. 09/834,511

ON BRIEF



Before THOMAS, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 25, appellants having canceled claims 26 through 37.

Representative independent claim 1 is reproduced below:

1. A method for providing Internet content via an interactive television, comprising the acts of:

prompting at least one consumer via the interactive television for input regarding topics of interest;

receiving consumer input regarding topics of interest;

transmitting the consumer input to a server; and

downloading the Internet content regarding topics of interest to the interactive television as the content regarding topics of interest becomes available and prior to receiving a consumer request for the Internet content.

The following references are relied on by the examiner:

Lawler et al. (Lawler)	5,699,107	Dec. 16, 1997
Shah-Nazaroff et al. (Shah-Nazaroff)	6,317,881	Nov. 13, 2001 (Filed Nov. 4, 1998)
Smith et al. (Smith)	6,742,033	May 25, 2004 (Filed Jun. 12, 2000)

Claims 1 through 25 stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1, 15, and 18 through 25, the examiner relies upon Shah-Nazaroff in view of Smith. In a second stated rejection the examiner relies upon Smith and Lawler as to claims 2 through 4, with the addition of Shah-Nazaroff as to claims 5 through 14 in a third stated rejection. Lastly, in a fourth stated rejection the examiner relies upon Shah-Nazaroff in view of Smith, further in view of Lawler as to claims 16 and 17.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for appellants' positions, and to the final rejection and answer for the examiner's positions.

OPINION

For the reasons set forth by the examiner in the answer, as expanded upon here, we sustain the various rejections of all claims on appeal under 35 U.S.C. § 103.

The arguments presented in the principal brief on appeal are directed only to independent claims 1 and 15 within the first stated rejection and claim 2 within the second stated rejection. No arguments are presented before us as to the third and fourth stated rejections or any other claims on appeal.

Within the first stated rejection, we turn to the subject matter of independent claim 1 on appeal. The language “as the content regarding topics of interest becomes available” in the last clause of claim 1 on appeal does not necessarily refer to the “Internet content” in the first part of this downloading clause and to the “Internet content” in corresponding language set forth in the last few words of this claim. Notwithstanding appellants’ repeated arguments beginning at the bottom of page 4 of the principal brief on appeal, there is no clear statement in claim 1 that it is the Internet content regarding topics of interest that is downloaded in the subclause “as the content regarding topics of interest becomes available.” Plainly, the claims distinguish between the usages of the terms “the Internet content” and “the content regarding topics of interest.”

Therefore, we do not agree with appellants continued inconsistency that in Shah-Nazaroff the reference does not teach the so-called “as” clause. We find ourselves in agreement with the examiner’s observations such as at the bottom of page 7 of the answer that the content in this portion of the claim is the form of the reference’s custom program listing per se, which appellants’ remarks at the bottom of page 4 of the reference plainly

admit that Shah-Nazaroff teaches. Throughout this reference, there's a continued teaching that the particular program listing and associated ratings provided by individual viewers, such as are provided for "potential subsequent viewers," comprise the claimed content in this portion of claim 1 on appeal. Appellants' remarks do not take the position that the claimed topics of interest are not taught in this reference. This so-called "as" clause of claim 1 on appeal is taught or clearly suggested to the artisan at least at columns 4 through 7 of the Shah-Nazaroff patent. We therefore agree with the examiner's additional observations at page 6 of the answer with respect to the examiner's interpretations of this subclause. It is worthy of noting that rating information may be sent to a prospective viewer in real time as discussed at the bottom of column 4.

Moreover, to the extent that Shah-Nazaroff does not teach actually downloading the content per se, assuming for the sake of argument that the claim may be interpreted as sending the Internet content regarding the topics of interest as they become available and prior to receiving a customer request for the Internet content, the teachings at columns 5 through 7 plainly indicate to the artisan that the user is given the ability to subsequently actually request Internet content related to the rating information received when it becomes next available or in fact the content provider intends to rebroadcast it. As such, the Shah-Nazaroff reference may in fact teach substantially all the subject matter of independent claim 1 on appeal without the additional reliance upon Smith.

On the other hand, to the extent the examiner is correct that Shah-Nazaroff is silent as to the disclosing the content availability feature as well as to do so prior to receiving customer request for content as alleged at the bottom of page 4 of the final rejection, the examiner's reliance upon the noted portions in Smith make it clear that the teachings of Smith would have been an obvious enhancement to the artisan upon the teachings in Shah-Nazaroff. Noting first that the structure of figure 1 of Shah-Nazaroff is taught in figures 8 and 9 of that reference, the system controller in figure 8 is shown in figure 9 to include a cache 904 which dovetails very clearly with the caching and cache structures 80 and 85 within figure 1 of Smith. Obviously, to actually pre-cache program content, that is, Internet content, information based on usage of monitoring teachings would have dovetailed very appropriately within 35 U.S.C. § 103 with the teachings in a structural sense with those in Shah-Nazaroff and provided a functional enhancement as well.

Further enhancements to Shah-Nazaroff system are also evidenced as to the subject matter of independent claim 15 on appeal. Notwithstanding the examiner's views with respect to this rejection apparently set forth at the bottom of page 5 of the final rejection that this reference does not disclose the notion of priority of viewing habits, the suggestibility of the priority of the type claimed is begun at the top of column 6, line 6 of Shah-Nazariff where it discusses the content provider having available to it a ranked list of broadcast content. This is subsequently discussed to the point of stating at column 7,

line 30 through 32 that “the first broadcast in the list is intended to be the most likely to be interesting to the viewer.” Again, the portions of Smith relied upon by the examiner (column 4, line 36 through column 5, line 12 and the significant discussion at column 6, lines 9 through 19) also dovetails with the already existing teaching in Smith and expands upon them as well.

Appellants’ remarks in the brief and reply brief as to claim 15 and Smith in the brief and reply brief do not appear to come to grips with the significant teaching value of the subject matter argued in independent claim 15 on appeal. Smith does teach to automatically download Internet content to a viewer based on monitored user activities to create an historical usage pattern database (topics of interest) based upon these usages to derive user-defined priority levels of topics of interest for different times of day as claimed. Based upon the noted teaching value of Smith, the artisan may also have well appreciated that the subject matter of independent claim 15 on appeal may be taught substantially by Smith alone anyway.

We turn next to the argued subject matter of independent claim 2 on appeal in the second stated rejection where the examiner relies upon Smith in view of Lawler within 35 U.S.C. § 103. The claim requires in part the determination of at least one topic of interest for at least one customer “without the user specifying the topic.” This negative limitation is apparently argued at the bottom of page 7 of the principal brief on appeal. Appellants allege that the examiner admits that Smith fails to show the user to specify the

topic of interest since the allegation is continued to be made that the algorithm does so instead. Since the claim requires the absense of the user specifying the topic, the teaching value of the automatic monitoring to derive user usage information for caching purposes meets the limitation of the claim as argued by the examiner.

Appellants' remarks at the bottom of page 7 of the principal brief on appeal do not argue against the teachings of Lawler as relied upon by the examiner. The examiner's view at the bottom of page 7 of the final rejection that Smith does not teach the notifying clause of independent claim 2 on appeal appears correct, but the artisan may well interpret the teaching at figure 4 of Smith with respect to block 234 that once the user actually accesses the pre-cached information, the customer is notified via the interactive television regarding Internet content concerning a topic of interest as broadly recited. To the extent the reference does not actively notify the viewer/user, Lawler clearly teaches advantageously to do so since the reference teaches many reminders are available here in this reference to the user shortly before the actual selected program becomes available.

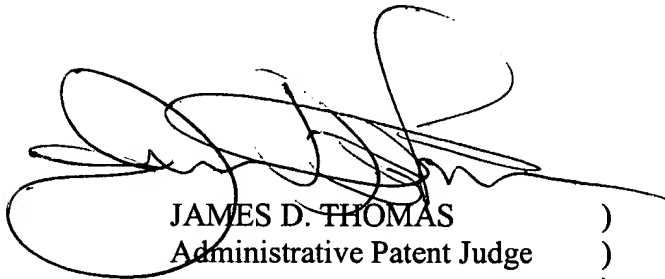
It is significant to note as well that the examiner's allegations that Smith is analogous art to Shah-Nazaroff in the first stated rejection and that Lawler in analogous art to Smith and the second stated rejection have not been contested by appellants in the brief and reply brief.

Lastly, we note in passing that Shah-Nazaroff may also be interpreted by the artisan as substantially anticipating the subject matter of independent claim 2 on appeal, including the negative limitation “without the user specifying the topic.” Once the viewer characteristics are determined in Shah-Nazaroff by the content provider or otherwise, the reference functions to determine at least one topic of interest and to actually notify the customer via the interactive television regarding Internet content concerning the topic of interest without the user specifying the topic. Correspondingly, the teaching value of Lawler would appear to be directly applicable to independent claim 2 on appeal on its own in a corresponding manner. Once the user program reminder panel has been set or stored, Lawler functions on its own within the context of independent claim 2 on appeal without the user specifying a topic. Because the user is reminded shortly before the selected program becomes available, the teaching value of Lawler as well is directly pertinent to the clause of independent claim 1 on appeal “as the content regarding topics of interest becomes available.” Clearly, the user can then choose to receive the requested content as set forth at the end of claim 1 on appeal.

In view of the foregoing, the decision of the examiner rejecting claims 1 through 25 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a)(1)(iv).

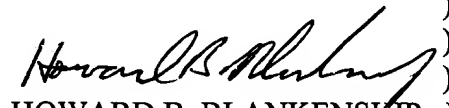
AFFIRMED



JAMES D. THOMAS
Administrative Patent Judge



JOSEPH F. RUGGIERO
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge

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